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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,293	11/17/2005	Hasso Meinert	037204.56176US	4649
23911 7590 11/06/2007 CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			EXAMINER ARNOLD, ERNST V	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 11/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/531,293	Applicant(s) MEINERT ET AL.	
	Examiner Ernst V. Arnold	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- ☒ Claim(s) 17-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_ is/are allowed.
- ☒ Claim(s) 17-38 is/are rejected.
- ☐ Claim(s) \_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- ☐ The specification is objected to by the Examiner.
- ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 1) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 2) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/14/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Claims 1-16 have been cancelled. Claims 17-38 are under examination.

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

The information disclosure statement filed 4/14/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The Examiner has drawn a line through the references. Please note that the foreign search report is in German and not listed on the information disclosure statement.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-37 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Claim 17 recites: A method for staining cells in

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the human or animal body, the method comprising applying to the cells in the body a physiologically compatible aqueous solution of a dye which does not represent a vital dye and is biocompatible. By definition it is impossible for a dye that stains a cell or tissue to be anything other than a vital dye. Vital in biology means: used or done on a living cell or tissue; vital dyes (vital; answers.com,). Therefore, if the dye stains the cell it is a vital dye and must represent a vital dye.

Claims 38 and 39 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Claim 37 recites: A physiologically compatible aqueous dye solution for coloring cells in the human or animal body, the dye solution comprising at least one dye which does not represent a vital dye and is biocompatible. By definition it is impossible for a dye that stains/colors a cell or tissue to be anything other than a vital dye. Vital in biology means: used or done on a living cell or tissue; vital dyes (vital; answers.com). Therefore, if the dye stains/colors the cell it is a vital dye and must represent a vital dye.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 22-36 are dependent on cancelled claim 16. In the interest of compact prosecution, the Examiner will examine these method claims

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as if they were dependent on independent method claim 17. However, appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 17-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 recites: A method for staining cells in the human or animal body, the method comprising applying to the cells in the body a physiologically compatible aqueous solution of a dye which does not represent a vital dye and is biocompatible. However, it is unclear to the Examiner how a dye can stain a cell in the human or animal body and not be a vital dye. Vital in biology means: used or done on a living cell or tissue; vital dyes (vital; answers.com). Claims 18-36 are rejected for being indefinite because the Examiner is examining them as if they were dependent on indefinite independent method claim 17.

***Claim Rejections - 35 USC § 112***

Claims 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 37 recites: A physiologically compatible aqueous dye solution for coloring cells in the human or animal body, the dye solution comprising at least one dye which does not represent a vital dye and is biocompatible. However, it is unclear to the Examiner how a dye can stain a cell in the human or

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animal body and not be a vital dye. Vital in biology means: used or done on a living cell or tissue; vital dyes (vital; answers.com). Claim 38 is rejected as being indefinite because it is dependant on an indefinite base claim.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Buono US 2003/0096334 (published on 05/22/03) and has matured into US 7,014,991 teaches methods of staining an ocular structure such as the anterior lens capsule and the vitreo-retinal interface comprising staining the ocular structure with patent blue V (Abstract and claim 1).

No claims are allowed.

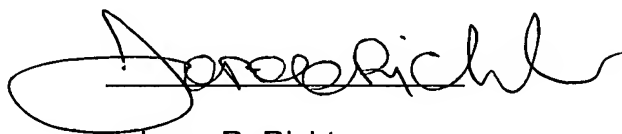
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernst V. Arnold whose telephone number is 571-272-8509. The examiner can normally be reached on M-F (6:15 am-3:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ernst Arnold  
Patent Examiner  
Technology Center 1600  
Art Unit 1616

A handwritten signature in black ink, appearing to read 'Johann R. Richter', written over a horizontal line.

Johann R. Richter  
Supervisory Patent Examiner  
Technology Center 1600